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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			BOYCE, ANDRE D	
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6 BEFORE THE BOARD OF PATENT APPEALS
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9 AND INTERFERENCES
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11

12 *Ex parte* DEVIN F. HOSEA, ARTHUR P. RASCON,
13 RICHARD S. ZIMMERMAN, ANTHONY SCOTT ODDO,
14 and NATHANIEL THURSTON
15

16 Appeal 2009-003176
17 Application 09/558,755
18 Technology Center 3600
19

20 Decided: ¹ May 28, 2009
21

22 Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
23 ANTON W. FETTING, *Administrative Patent Judges*.
24

25 CRAWFORD, *Administrative Patent Judge*.
26

27 DECISION ON APPEAL
28
29

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 STATEMENT OF CASE

2 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
3 of claims 1 to 3, 7 to 10, 13 to 22, 24 to 38, 42, 43 and 46 to 63. We have
4 jurisdiction under 35 U.S.C. § 6(b) (2002).

5 Appellants invented a method and system for profiling a Web user
6 (Spec. 1).

7 Claim 1 under appeal reads as follows:

8 1. A method of profiling a Web user, comprising:
9 providing profiles on a plurality of Web sites;
10 using a computer to monitor user access to said plurality of Web sites
11 by identifying the URL requests made by the user at the Internet
12 Service Provider (ISP) point of presence (POP); and
13 using a computer to develop a profile of the user by inferring
14 user demographics based on the profiles of the Web sites accessed by
15 the user.

16
17 The Examiner rejected claims 1 to 3, 7 to 10, 13, 14, 20, 22, 24, 26 to
18 38, 42, 43, 46 to 57, 62 and 63 under 35 U.S.C. § 103(a) as being
19 unpatentable over Roth in view of Armbruster and Bull.

20 The Examiner rejected claim 15 to 18 under 35 U.S.C. § 103(a) as
21 being unpatentable over Roth in view of Armbruster, Bull and Sheena.

22 The Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being
23 unpatentable over Roth in view of Armbruster, Bull and Eldering.

24 The Examiner rejected claims 21 and 58 to 61 under 35 U.S.C.
25 § 103(a) as being unpatentable over Roth in view of Armbruster, Bull and
26 Park.

27 The Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being
28 unpatentable over Roth in view of Armbruster, Bull and Haitsuka.

1 The prior art relied upon by the Examiner in rejecting the claims on
2 appeal is:

3	Sheena	US 6,049,777	Apr. 11, 2000
4	Bull	US 6,208,975 B1	Mar. 27, 2001
5	Armbruster	US 6,243,760 B1	Jun. 5, 2001
6	Roth	US 6,285,987 B1	Sep. 4, 2001
7	Park	US 6,295,061 B1	Sep. 25, 2001
8	Eldering	US 6,298,348 B1	Oct. 2, 2001
9	Haitsuka	US 6,366,298 B1	Apr. 2, 2002

ISSUES

12 Have Appellants shown that the Examiner erred in finding that
13 Armbruster discloses using a computer to monitor users access to a Web site
14 by identifying the URL requests made by the user at the Internet Service
15 Provider (ISP) point of presence?

16 Have the Appellants shown that the Examiner erred in rejecting the
17 claims on appeal because there is no reason to combine the teachings of
18 Roth and Armbruster?

FINDINGS OF FACT

20 Roth discloses a method of profiling a Web user which includes the
21 step of using a computer to monitor user access to a plurality of Web sites
22 (col. 1, ll. 29 to 33).

23 Armbruster discloses a method which allows a user to access content
24 from a content provider. The content provider is able to split content into
25 cached and non-cached elements. The cached elements are stored at an ISP
26 caching complex 10 disposed at the user's internet service provider ("ISP")
27 point of presence (col. 3, ll. 34 to 36). The content provider is able to direct

- 1 a user to cached or non-cached elements by identifying the URL of the
- 2 request (col. 4, ll. 45 to 49).

3 PRINCIPLES OF LAW

4 An invention is not patentable under 35 U.S.C. § 103 if it is obvious.

5 *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1745-46 (2007). The facts

6 underlying an obviousness inquiry include: Under § 103, the scope and

7 content of the prior art are to be determined; differences between the prior

8 art and the claims at issue are to be ascertained; and the level of ordinary

9 skill in the pertinent art resolved. Against this background the obviousness

10 or nonobviousness of the subject matter is determined. Such secondary

11 considerations as commercial success, long felt but unsolved needs,

12 failure of others, etc., might be utilized to give light to the circumstances

13 surrounding the origin of the subject matter sought to be patented. *Graham*

14 *v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In addressing the findings of

15 fact, “[t]he combination of familiar elements according to known methods

16 is likely to be obvious when it does no more than yield predictable results.”

17 *KSR* at 1739. As explained in *KSR*: If a person of ordinary skill can

18 implement a predictable variation, § 103 likely bars its patentability. For

19 the same reason, if a technique has been used to improve one device, and

20 a person of ordinary skill in the art would recognize that it would improve

21 similar devices in the same way, using the technique is obvious unless its

22 actual application is beyond his or her skill. *Sakraida and Anderson's-Black*

23 *Rock* are illustrative - a court must ask whether the improvement is more

24 than the predictable use of prior art elements according to their established

25 functions. *KSR* at 1740.

1 A prior art reference is analyzed from the vantage point of all that it
2 teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009
3 (1968) (“The use of patents as references is not limited to what the patentees
4 describe as their own inventions or to the problems with which they are
5 concerned. They are part of the literature of the art, relevant for all they
6 contain.”). Furthermore, “[a] person of ordinary skill is also a person of
7 ordinary creativity, not an automaton.” *KSR* at 1742.

8 On appeal, Appellants bear the burden of showing that the Examiner
9 has not established a legally sufficient basis for combining the teachings of
10 the prior art. Appellants may sustain its burden by showing that where the
11 Examiner relies on a combination of disclosures, the Examiner failed to
12 provide sufficient evidence to show that one having ordinary skill in the art
13 would have done what Appellants did. *United States v. Adams*, 383 U.S. 39
14 (1966).

ANALYSIS

17 We are not persuaded of error on the part of the Examiner by
18 Appellants' argument that Armbruster does not disclose monitoring a user's
19 access to a plurality of Web sites by identifying the URL requests made by
20 the user at the ISP point of presence. It is clear as we found above that the
21 cached items disclosed in Armbruster are located at the ISP point of
22 presence rather than near the point of presence as argued by Appellants. In
23 addition, the action of directing the user to the cached items or to the non-
24 cached items occurs at the ISP point of presence and is monitoring as
25 broadly claimed.

1 We are also not persuaded by Appellants' argument that Armbruster
2 does not disclose monitoring a plurality of websites but rather at best can
3 only be used to monitor a single website. Even if Appellants are correct that
4 Armbruster discloses monitoring only one website, such is not fatal to the
5 Examiner's rejection because Roth discloses monitoring a plurality of
6 websites.

7 We are also not persuaded by Appellants' arguments that there is no
8 motivation to combine the teachings of Roth, Armbruster, and Bull because
9 Roth and Bull are concerned with the art of profiling web users and
10 Armbruster is concerned with information dissemination. Roth teaches that
11 user access can be monitored by identifying URLs but does not disclose
12 that the identification takes place at the ISP point of presence. Armbruster
13 is relied on for teaching that monitoring of user access by identifying
14 URLs can take place at the ISP point of presence. As such, in our view the
15 identification of URLs at the ISP point of presence in the Roth method is not
16 more than the combination of familiar monitoring step according to known
17 methods to yield a predictable result.

18 In view of the foregoing, we will sustain this rejection as it is directed
19 to claim 1. We will also sustain the rejection as it is directed to claims 2, 3,
20 7 to 10, 13, 14, 20, 22, 24, 26 to 38, 42, 43, 46 to 57, 62 and 63 because the
21 Appellants have not argued the separate patentability of these claims.

22 We will sustain the remaining rejections because the Appellants rely
23 on the arguments advanced in regard to claim 1 to traverse the remaining
24 rejections.

25

